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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,962	03/23/2001	John E. Wilson	14460/04023	6477
24024	7590	12/29/2005	EXAMINER	
CALFEE HALTER & GRISWOLD, LLP 800 SUPERIOR AVENUE SUITE 1400 CLEVELAND, OH 44114			GOODMAN, CHARLES	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/815,962

Applicant(s)

WILSON, JOHN E.

Examiner

Charles Goodman

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 and 14-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-13 and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

Art Unit: 3724

### **DETAILED ACTION**

1. The Amendment filed on October 5, 2005 has been entered.

### ***Election/Restrictions***

2. Claims 1-9 and 14-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected Groups, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 14.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 10, 11, and 19-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Benecke (DE 1 183 665)<sup>1</sup> in view of Koponen et al (US 5,852,963).

Benecke discloses what appears to be an apparatus for trimming scrap comprising all elements claimed including, inter alia, a scrap receiver (5); an inherent nozzle (note e.g. the arrows opposite reference 6 in the Figure) directing a stream of fluid generally opposite the direction of strip travel; and a knife roll (2). See whole

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<sup>1</sup> Benecke is a reference cited by Applicant in an IDS filed on August 12, 2002.

Art Unit: 3724

patent. However, if it is argued that Benecke lacks the direction of fluid application and/or a nozzle, then Koponen et al teaches a nozzle (at 40 in Fig. 17) for directing the air stream generally opposite the direction of web travel in order to remove debris. Note c. 7, ll. 19-31. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Benecke with the nozzle directing fluid in the generally opposite direction of strip travel as taught and suggested by Koponen et al in order to facilitate the waste strip removal.

5. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benecke (DE 1 183 665) in view of Koponen et al (US 5,852,963) as applied to claims 10, 11, and 19-21 above, and further in view of Frye (US 4,410,315).

Benecke, alone or modified, discloses the invention substantially as claimed including an inherent discontinuity as claimed due to the fact that air nozzles are typically designed in such a manner to control the fluid dynamics of the air, e.g. the bore in the wall of the nozzle is construed as reading on the discontinuity. If it is argued that Benecke, alone or modified, lacks such a feature, then it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Benecke, alone or modified, with the discontinuity in order to facilitate controlled discharge of the fluid, since one of ordinary skill in the art would have the knowledge of fluid dynamics to design the nozzle accordingly to reduce Coanda effects, and since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art, especially since such a change does not render unexpected or unobvious results. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Art Unit: 3724

On the other hand, Frye clearly teaches a nozzle (33) that have the features claimed in claims 12 and 13.<sup>2</sup> It is clear from the teachings of Frye, that the nozzle (33) is equivalent to the nozzle of Benecke, alone or modified, in that both direct something of the work. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to substitute the nozzle of Frye for the nozzle of Benecke, alone or modified, in order to facilitate directing of the web material, since both are deemed to equivalent product handling means, since substitution of one for the other is deemed to be an obvious matter of design choice and both appear to work equally well.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 10-13 and 19-21 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (571) 272-4508. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.

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<sup>2</sup> In relation to the teachings of Frye, it appears that Applicant is not contesting that Frye teaches the features claimed in claims 12 and 13 due to the fact that Applicant's current arguments are hinged upon whether Frye teaches the nozzle directing scrap strip as opposed to the structure of the nozzle itself. Thus, the Examiner's basis in the last Office Action applies equally here.


Art Unit: 3724

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap, can be reached on (571) 272-4514. In lieu of mailing, it is encouraged that all formal responses be faxed to (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



**Charles Goodman**  
**Primary Examiner**  
**AU 3724**

cg   
December 27, 2005

CHARLES C  
HARRY